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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,764	07/20/2005	Isao Kishinami	273222US3PCT	9318
22850 7590 01/21/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER WATTS, JENNA A	
			ART UNIT 4132	PAPER NUMBER
			NOTIFICATION DATE 01/21/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/542,764	Applicant(s) KISHINAMI, ISAO	
	Examiner JENNA A. WATTS	Art Unit 4132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20050720 and 20081112</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I in the reply filed on 12/17/2008 is acknowledged.
2. The restriction requirement is deemed proper and therefore made FINAL.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. It is unclear what level of pressure encompasses "normal pressure". For the purposes of examination, "normal pressure" will be considered atmospheric pressure.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwa (EP Patent Application No. 1264546) in view of Morris, P.C. et al. (Cereal Biotechnology, 2002).

9. Regarding Claim 1, Kuwa teaches a method of impregnating cereal grains (Page 2, Paragraph 21, Page 3, Paragraph 26) with water (Page 4, Paragraph 40), wherein the cereal grains and water are placed/stored in a pressure reducing container for impregnation/absorption of the cereals with water, thereby soaking/immersing the cereals in the water (Page 6, Paragraph 55). Kuwa further teaches that the resulting foods, which have been vacuum treated and contacted with the liquid component in the maintained vacuum state, are then subjected to pressurization by releasing the vacuum state, thereby impregnating the foods with the liquid (Page 6, Paragraphs 51 and 56). It would be expected that the pressure reducing apparatus would be pressure-resistant.

10. Kuwa further teaches that the disclosed method is a simple method of impregnating foods with the liquid component in a very short period of time (Page 9, Paragraph 85).

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11. Kuwa does not specifically teach that the cereal grains can be barley.
12. Morris et al. teaches that barley is pre-eminent among cereals which are malted and malting is divided into three stages, one of which is steeping, wherein the moisture content of the grain is increased by water immersion (Page 186, Section 9.3, lines 26-27, Section 9.3.1, line 33 and Page 189, Section 9.3.3, lines 9-10). Morris teaches that barley must be able to hydrate quickly because it accelerates malting, which is a benefit to the person conducting the malting process (Table 9.1, Page 188). Morris further teaches that the barley must be able to be easily, rapidly and consistently converted into malt (Page 186, Section 9.3.1, lines 36-39).
13. Various practices have been used to accelerate the steeping, and thus malting process, however some processes have been phased out of practice (Page 189, Section 9.3.3, lines 15-19, 26-28 and 33-34), and other processes have been optimized in order hydrate the grain quickly (Page 189, Section 9.3.3, lines 26-28).
14. It would have been obvious to one of ordinary skill in the art at the time of the invention for the method of grain impregnation taught by Kuwa to have been conducted on barley because Morris teaches that barley is commonly malted and it is important to hydrate the barley quickly and easily in order to accelerate the malting process. One of ordinary skill in the art would have been motivated to use the disclosed grain impregnation process on barley in order to simply and quickly hydrate the barley in order to accelerate the malting process, thus increasing the efficiency of production of malted beverages.

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15. Regarding Claim 2, Kuwa teaches that the step of releasing the reduced pressure can be done by releasing the vacuum state by air purging to restore the pressure to atmospheric pressure. Thus, it is understood that this process of air purging would result in the abrupt release of the vacuum. Normal pressure is interpreted to be atmospheric pressure.

16. Regarding Claim 3, Kuwa teaches that in the vacuum treatment, the pressure condition is about 10 to 50,000 Pa (Page 6, Paragraph 55), however, the pressure in the vacuum treatment can be appropriately controlled depending on the temperature condition and the desired impregnation degree (Page 5, Paragraph 47). Kuwa further teaches that as the pressure decreases and the vacuum degree increases, the air contained in the foods is eliminated more effectively so that high-level impregnation can occur (Page 5, Paragraph 48). Kuwa teaches that the cereal grains are contacted with the water while being kept in the vacuum state (Page 6, Paragraph 51), thus the vacuum is maintained at a certain period during the impregnation/immersion process.

17. Kuwa does not specifically teach that the step of reducing the pressure in the pressure-resistant container is to maintain a degree of vacuum at about 10^{-4} Torr at a certain period.

18. Nevertheless, the above-mentioned teachings of Kuwa indicate that the exact pressure of the vacuum treatment is a result effective variable with regard to the hydration of the barley grains. It would require only routine experimentation to determine the optimum value of a result effective variable, such as the exact pressure of

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the vacuum treatment, in the absence of a showing of criticality in the claimed pressure of the vacuum treatment. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated by Kuwa to modify the pressure of the vacuum treatment in order to optimize the level of impregnation desired. One would have been motivated to decrease the pressure in the vacuum treatment in order for high-level impregnation to occur, as taught by Kuwa, in order produce fully hydrated barley grains for malting.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNA A. WATTS whose telephone number is (571)270-7368. The examiner can normally be reached on Monday through Thursday from 9am to 5pm.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Lavilla, can be reached on (571) 272-1539. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J. A. W./

J. Watts

Examiner, Art Unit 4132

January 9, 2009

/Michael La Villa/

Michael La Villa

Supervisory Patent Examiner, Art Unit 4132

13 January 2009